Supreme Court, U. S.
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IN THE

# Supreme Court of the United States

OCTOBER TERM, 1977.

**No. 77-1**

ERICH F. MEITZNER AND JAMES A. OLINE,
*Petitioners,*

*vs.*

MORRIS MINDICK AND JERRY SVARZ,
*Respondents.*

## BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

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The present petition requesting a review of the decision of the Court of Customs and Patent Appeals (CCPA) is based on two grounds. First, according to petitioners there exists a conflict between the decision below and the decisions of this Court. Second, the Court is asked to determine whether the Patent and Trademark Office (PTO) can issue a patent to one found not to be the first inventor. Neither the facts of the present case nor the law in point support either of petitioners' arguments.

## I. CONFLICT IN DECISIONS.

There is no conflict between the decision of the PTO (unanimously affirmed by the CCPA) and the decisions of this Court. The PTO held that petitioners were estopped to contest priority of invention because of their failure to act in a previous interference (see Appendix to Petitioners' Brief, page 17a). The Doctrine of Junior Party Estoppel has been in existence in interference practice for well over fifty years. It is defined in the standard work in this field, 2 Revise and Caesar, *Interference Law and Practice* § 243 (1943), as follows:

> "For present purposes, it may be stated that, generally speaking, if an interference is dissolved, no claim to common patentable subject matter can afterwards be allowed to the junior party, and the junior party is estopped to claim any invention which is disclosed in any application of the senior party to which the junior party has access."

The reasoning behind the estoppel doctrine was explained in part by the Commissioner of Patents in *White* v. *Ovaitt*, 1923 C. D. 18, 308 O. G. 449 (1922), as follows:

> "This is a desirable and salutary rule. The parties having once been brought face to face and their respective applications having been once disclosed each to the other, they are given the option to elect whether they will contest priority with each other or whether they will waive that question and each take a patent for his own separate invention. . . ."

Petitioners cite no specific authority to support their argument that the decision below is in conflict with the decisions of this Court. In fact, the estoppel doctrine applied in the present case is most analogous to the judicially created Doctrine of Collateral Estoppel which has been expanded upon and enforced by this Court in recent years. See for example *Blonder-Tongue Labs., Inc.* v. *University of Ill. Foundation*, 402 U. S. 313 (1971).

## II. FIRST INVENTORSHIP QUESTION.

Petitioners have asked the Court to determine whether the PTO can issue a patent to one found not to be the first inventor. Inasmuch as respondents' patent issued to Mindick and Svarz as joint inventors prior to the subject interference being declared, this argument is completely without any logical or factual basis. The PTO was not asked to issue a patent to respondents during the course of the interference proceedings. Rather, the sole issue before the PTO and CCPA was whether *petitioners* were entitled to a patent and this question was determined adversely to them on the basis of legally sound grounds.

## III. THE QUESTIONS PRESENTED IN THE PETITION ARE MOOT.

A further reason for denying the writ is that the issues presented in this petition have become moot as a result of subsequent action on the part of respondents. The decision of the PTO led respondents to conclude that a joint invention had been made by Mindick, Svarz and Wen. Therefore, a Petition was promptly filed under 35 C. F. R. § 1.324 to add Wen, a coworker with Mindick and Svarz, as a third joint inventor. (A copy of the Petition and accompanying Affidavit are appended.)

The statutory basis for such conversion is clear under 35 U. S. C. § 256. Factually the PTO noted that the ion exchange resins prepared by Wen fell within the scope of counts 1 through 4 and that the resins subsequently prepared by Svarz fell within the scope of all counts of this interference (Appendix to Petitioners' Brief, page 27a). Furthermore, it has been shown that all of this work by Mindick, Svarz and Wen was carried out long before the work of Meitzner et al. referred to in Petitioners' Brief.

The Petition to add Wen as a coinventor is now pending before the PTO and will be acted upon as soon as the mandate

from the CCPA issues. Under these circumstances the questions presented by the present petition are clearly moot.

On the basis of the foregoing arguments, respondents urge that the petition for a Writ of Certiorari be denied.

Respectfully submitted,

HERBERT B. KEIL,
MICHAEL P. BUCKLO,
KEIL, THOMPSON & SHURTLEFF,
135 South LaSalle Street,
Chicago, Illinois 60603,
*Attorneys for Respondents.*

Of Counsel:
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LLOYD S. JOWANOVITZ,
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THE DOW CHEMICAL CO.,
Midland, Michigan 48640.

# APPENDIX.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.

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| U. S. Patent No. 3,549,562<br>MORRIS MINDICK,<br>and<br>JERRY J. SVARZ. | Petition Under Rule 324.<br>Misjoinder of Inventors. |

Hon. Commissioner of Patents and Trademarks
Washington, D. C. 20231

Sir:

The Dow Chemical Company, assignee of the entire right and interest under U. S. Patent No. 3,549,562, and Morris Mindick and Jerry J. Svarz, inventors named in said United States Patent No. 3,549,562, hereby petition the Commissioner under Rule 324 to correct an inventorship error. The name of Richard Wen was not included in the application that led to said Patent No. 3,549,562 by error and without deceptive intention. It was the opinion of the attorney in charge of this case (see the attached affidavit of Herbert B. Keil) that Morris Mindick should be considered a sole inventor of the claims of the patent except for claim 10. The Board of Patent Interferences ruled in a decision dated April 15, 1975, (copy attached) however, that the evidence did not show that Morris Mindick, as a sole inventor, conceived and actually reduced to practice the invention set out in the claims of the patent. Rather, the Board of Patent Interferences stated that:

> ". . . the ion exchange resins prepared by Wen and method used by Wen to prepare those ion exchange resins, while falling within the scope of counts 1 through 4, do not fall within the scope of counts 5 through 10." (Decision—Page 27)

The Board further stated that:

> "The various ion exchange resins prepared by Svarz and the method used by Svarz to prepare those ion exchange resins fall within the scope of all counts." (Page 27)

It follows from the Board's decision, therefore, that Mindick, Svarz and Wen should be co-inventors.

In order to make certain of the inventorship question, the party Mindick et al filed a petition (copy attached) asking the Board of Patent Interferences to reconsider its decision. The proofs relied upon by Mindick to support his claim to be a sole inventor were set forth and the Board was asked for its further comments in view of this presentation. In a decision dated August 7, 1975 and received by the party Mindick et al on August 11, 1975, the Board adhered to its original position (copy attached).

All of the facts were laid before the Board of Patent Interferences and every attempt was made to be as open and candid with respect to the inventorship question as was possible. It appears that the incomplete inventor entity was due to an error of interpretation on the part of petitioners' attorney and that all three men should have been included in the patent. The attached affidavits of Morris Mindick, Jerry J. Svarz and Richard Wen attest to this fact.

Favorable action on this petition is solicited.

Respectfully submitted,

THE DOW CHEMICAL COMPANY,

By /s/ WILLIAM M. YATES Sept. 4, 1975,
William M. Yates,

/s/ MORRIS MINDICK 8/28/75,
Morris Mindick,

/s/ JERRY J. SVARZ, 8/16/75,
Jerry J. Svarz,

/s/ RICHARD Y. WEN 8/22/75,
Richard Wen.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE.
Before the Board of Patent Interferences.

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|---|---|
| U. S. Patent No. 3,549,562<br>MORRIS MINDICK,<br>and<br>JERRY J. SVARZ. | Misjoinder of Inventors.<br>Attn: Solicitor's Office. |

AFFIDAVIT UNDFR RULE 324.

STATE OF ILLINOIS, }
COUNTY OF COOK. } ss:

I, Herbert B. Keil, being first duly sworn, depose and say as follows:

I am the attorney who was in charge of the application leading to the issuance of U. S. Patent 3,549,562 and the attorney in charge of presenting the evidence of inventorship on the part of Mindick et al in Interference No. 97,787. I began working on the prosecution of the case in about 1961 which was at least four years after the filing date of the application. It was assumed by me that Morris Mindick and Jerry J. Svarz were properly named as co-inventors in the application. In reviewing the documents preparatory to Interference No. 97,787, however, I took the position that Morris Mindick should be considered as a sole inventor. The basis for my conclusion was set out on pages 6 through 9 of the attached Petition for Reconsideration and/or Clarification. Because of my belief that Morris Mindick was a sole inventor, the Preliminary Statement in Interference No. 97,787 was filed solely by Morris Mindick. It was recognized that Jerry J. Svarz did, in fact, contribute to the invention set forth in claim 10 of the patent. It was our intention to convert the joint invention to a sole invention as soon as the Interference was decided and to disclaim the subject matter of claim 10. The decision of the Board of Patent Interferences was to the

effect that the evidence did not show that Morris Mindick *alone* actually conceived and reduced to practice the invention of the counts of the Interference. It was stated by the Board that Richard Wen had carried out experiments and produced ion exchange resins and beads which satisfied the requirements of counts 1 to 4 of the Interference and that Jerry J. Svarz had carried out experiments and produced ion exchange resins and beads which satisfied the limitations of all of the counts of the Interference. The Board adhered to its position on reconsideration. It appears, therefore, that I was mistaken and that the patent should bear the names of Morris Mindick, Jerry J. Svarz and Richard Wen as co-inventors. Much of the work of Richard Wen is set forth in the table in the patent under the designations RW-585, RW-587, RW-590, RW-596, RW-597 and RW-598. As is apparent, Mr. Wen did a considerable amount of work in connection with the invention. Copies of the pertinent laboratory notebook pages of Richard Wen are attached hereto.

It is asserted that the error in naming the proper inventors on the patent was committed through inadvertence and without any deceptive intention. This petition has been filed with as much diligence as possible following the receipt on August 11, 1975 of the decision of the Board of Patent Interferences on reconsideration.

Wherefore your affiant has hereunto placed his hand and seal this 28th day of August, 1975.

/s/ HERBERT B. KEIL,
Herbert B. Keil,
Reg. No. 18,967.

Subscribed and sworn to before me this 29th day of August, 1975.

My Commission Expires: Nov. 5/75.

/s/ FLORENCE M. MAY,
*Notary Public, Cook County, Illinois.*

(SEAL)